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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,823	04/23/2001	Itsuo Watanabe	566.39636X00	9887

20457 7590 01/21/2003

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EXAMINER

CAIN, EDWARD J

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 01/21/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/762,823	Abanale et al
Examiner	Edward Cain	Group Art Unit 1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**P r i o r i t y Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

**D i s p o s i t i o n o f C l a i m s**

- Claim(s) 1-22 and 26-32 is/are pending in the application.
- Of the above claim(s) 22 and 26-31 is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 1-21 and 32 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 1-22 and 26-32 are subject to restriction or election requirement.

**A p p l i c a t i o n P a p e r s**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**P r i o r i t y u n d e r 35 U.S.C. § 119 (a)-(d)**

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

**A t t a c h m e n t ( s )**

- Information Disclosure Statement(s), PTO-1449, Pap r No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

Art Unit: 1714

1. The response to restriction received September 27, has been made of record.
- Claims 1-22 and 26-32 are pending.
2. The election of species requirement made in the last Office Action is withdrawn.
3. Therefore, claims 1-21 and 32 are being examined and claims 22 and 26-31 are withdrawn from consideration.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of these claims recites 10 to 200 by weight of inorganic filler per 100 parts by weight of an adhesive resin composition. Since the "adhesive resin composition" is considered as including the resin and the filler, the upper limit of 200 for the filler alone is not understood.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

7.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-2 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe et al.

Watanabe et al disclose adhesive composition comprising both insulative and conductive fillers (see column 4, line 22 to column 5, line 3). The adhesive are taught as having a modulus of elasticity of between 100 and 2,000 MPA at 40<sup>0</sup>C. The inorganic fillers are taught to be present in amounts at least greatly overlapping those claimed involved.

9. Any inquiry concerning this communication from the examiner should be directed to Edward Cain whose telephone number is (703) 308-0042. The examiner can generally be reached on Monday-Friday 10:00 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application is assigned are (703) 872-9311 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0661.

Art Unit: 1714

E. Cain/dh  
January 15, 2003

A handwritten signature in black ink, appearing to read "E. Cain".